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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,759	12/30/2003	Nathaniel Blake Scholl	249768082US	2699
25096	7590	04/04/2007	EXAMINER	
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/04/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/748,759	SCHOLL ET AL.
	Examiner Yehdega Retta	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 December 2006.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 3/23/06, 12/22/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 18 recites the limitation "calculating *the bid amount* based on". There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19, 22-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Colace et al. (US 6,826,572).

Regarding claims 1-3, Colace teaches generating advertisement sets, each identifying keyword and an advertisement; calculating fee amounts for advertisements (see fig. 15-17); sending to an advertisement placement service a request to place an identified advertisement along with content associated with the identified keyword at a fee amount (bid); receiving from the advertisement sets and a fee amount and providing a request to place an advertisement

associated with the advertisement set at the received fee amount; generating advertisement sets (see col. 12 lines 4-67, col. 2 lines 5-27); using different algorithms (see col. 11 lines 34-41).

Regarding claims 4 and 5, Colace teaches selecting an advertisement for the keyword based on an analysis of the likelihood of users selecting the advertisement, profit resulting from user selecting the advertisement (see col. 5 line 14 to col. 6 line 32, col. 11 line 43 to col. 12 line 4).

Regarding claims 6-8, Colace teaches multiple advertisement submitters; database containing statistics including average cost-per-click and an average revenue-per-click (see fig. 15-17, col. 5 line 45 to col. 6 line 32, col. 7 lines 1-27, col. 8 lines 27-36, col. 12 lines 21-38).

Regarding claims 9, 17-19, 22, 26-28 and 32 Colace teaches generating advertisement sets that specify a keyword and an advertisement and amounts for advertisements (see col. 5 line 45 to col. 6 line 32, fig. 15-17); requesting an advertisement placement service (search engine) to place advertisements in accordance with the selected advertisement set; analyzing the effectiveness of the placed advertisement for each advertising (col. 6 lines 1-32) selecting advertisement sets for placement of advertisements based on the analysis (see col. 12 lines 4-67, col. 2 lines 5-27, fig. 15-17); using different algorithms (see col. 11 lines 34-41).

Regarding claims 10-16, 23-25, 29, 30 and 31, Colace teaches the advertisement is placed with search results with a search term matching the keyword; effectiveness is based on profit resulting from user selecting the advertisement; calculating and adjusting the amount based on advertising metrics (see col. 5 line 14 to col. 6 line 32, col. 11 line 43 to col. 12 line 4).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 21, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colace.

Regarding claims 20, 21, 33 and 34 Colace does not explicitly teach generating advertisement sets based on frequency or desirability of keyword. Official notice is taken that is old and well known in the art of search engines to select advertisement based on frequency of desirability of keywords. It would have been obvious to one of ordinary skill in the art at the time of the invention to select advertisement based on frequency of desirability of keywords in order to identify the most relevant results among available documents, since the more the frequency of the keyword the more the document is relevant to the search query.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roetter et al. (US 20050160002 A1) teaches advertiser paying for advertising associated with one or more keywords relating to server 120 and determining user actions.

Soulanille (US 6978263 B2) teaches system and method for influencing a position on a search result list generated by a computer network search engine.

Chang (US 20040133469 A1) teaches system and method of promote website using Cycle Hits and Hits History.

Pisaris-Henderson et al. (US 20040162757 A1) teaches system and method for pay for performance advertising having biddable advertising units utilizing rotating routing to advertiser websites.

Calabria, Hermann et al. (US 20050144068 A1) teaches secondary market for keyword advertising.

Buck et al. (US 6,078,866) teaches Internet site searching and listing service based on monetary ranking of site listings.

Velez et al. (US 7043450 B2) teaches accumulating bid amounts for a plurality of target keywords and presenting the bid amounts to a user, enabling the user to evaluate and optimize bids on those keywords.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Yehdega Retta*  
RETTA YEHDEGA  
PRIMARY EXAMINER